BEFORE THE

Supreme Court of the United States

OCTOBER TERM, 1944.

Nos. ,

MINNESOTA MINING & MANUFACTURING COMPANY. *Petitioner,*

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent.*

BRIEF IN SUPPORT OF PETITION FOR WRITS OF CERTIORARI.

The Opinion of the Court Below.

The opinion of the Court of Appeals for the District of Columbia is reported at F. (2d) , 62 USPQ 119, and appears in the record filed herewith (R. 417-19).

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked follow:

(1) The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925.

(2) The judgments of the United States Court of Appeals for the District of Columbia were entered on

July 10, 1944, and its decision denying petitioner's petition for rehearing therein was rendered on September 8, 1944.

(3) The foregoing judgments were entered on appeal from judgments by the District Court for the District of Columbia in two civil actions brought under the Revised Statutes, Section 4915, 35 U. S. C. 63, as amended by Act of August 5, 1939, to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent or patents to petitioner as assignee of the application of Clifford L. Jewett, Serial No. 700,632, filed December 1, 1933, and of the further, related application of Clifford L. Jewett, Serial No. 305,294, filed November 20, 1939.

(4) Some of the previous decisions of this Court which are believed to sustain jurisdiction in this case are:

Gandy v. *Marble*, 122 U. S. 432.
Butterworth v. *Hill*, 114 U. S. 128.
Steinmetz v. *Allen*, 192 U. S. 543.
American Steel Foundries v. *Robertson*, 262 U. S. 209.
The Hoover Co. v. *Coe*, Petition No. 486 (granted November 6, 1944).

Statement of the Case.

The facts are set forth in the petition.

Specification of Errors.

The errors which the petitioner will urge, if the writs of certiorari are issued, are that the Court of Appeals for the District of Columbia erred:

(1) In affirming the dismissal of petitioner's bill of complaint, upon the grounds that the district court had no jurisdiction under the provisions of Section

4915 R. S., or, alternatively, in failing to rule on the main issue thus presented by the appeal.

(2) In holding, contrary to past practice, that petitioner was not entitled to relief under the provisions of Section 4915 R. S. after having been refused a patent by the Board of Appeals and because he had not established priority over another, *i.e.* Veazey (R. 193, 197), claiming the same invention, the Patent Office (contrary to its long established practice) having refused to set up an interference to determine the question of priority after having been requested to do so by petitioner.

(3) In holding, as it also did in *Hoover* v. *Coe, supra,* and contrary to past practice, that petitioner is not entitled to relief under Section 4915 R. S. because a third party, who was not an adverse party to petitioner in the Patent Office, was not made a party defendant to the action in addition to the Commissioner of Patents, there having been a refusal to grant the patent to petitioner by the Board of Appeals of the Patent Office but no interference or decision by the Board of Interference Examiners.

(4) In refusing or failing to decide the case upon its merits, and on the basis of the main issues directly raised by the appeal, and instead failing to decide the main issue and dismissing upon the grounds of lack of jurisdiction.

Highlights Of Pertinent Facts.

The Court of Appeals, D. C., in the instant causes, as in the *Hoover case*, 144 F. 2d 514, has held that it does not have jurisdiction to rule on the question of support in the Jewett application Serial No. 700,632, here in issue, for the two claims copied from the Veazey patent, aforementioned. The claims copied from the Veazey patent had been

allowed to Veazey as a result of a decision of the Board of Appeals of the Patent Office and Veazy's application was filed in the Patent Office approximately eight months later than the filing date of petitioner's assignor. The Commissioner of Patents has held the two claims to be patentable, and they are presently extant in the Veazey patent, and the issue presented to the court of appeals in the instant causes was the question of support, in the Jewett application Serial No. 700,632, for claims 8 and 9 of the Veazey patent (R. 197), which are claims 71 and 72 of said Jewett application (R. 25). On the basis of the trial court's findings (R. 170-175) in the earlier R. S. 4915 action involving the same Jewett application Serial No. 700,632 (especially see paragraph 6 of said findings) it has been, in effect, fully adjudicated that the Jewett invention responds to, and the Jewett application supports the two claims copied from Veazey; and the decision of the district court (Judge McGuire) in Civil Action No. 13,832 (R. 158-9) is logically irreconcilable with the final and unappealed judgment of the same court (Judge Luhring) (R. 170-6) in the earlier R. S. 4915 action involving the same Jewett application, and the Court of Appeals D. C. failed and refused to resolve this conflict and disposed of the appeal on the basis that it and the district court (Judge McGuire) were without jurisdiction to decide the question of support for the claims copied from the patent, when it was "*not clear*" that a subsequent interference might not be necessary in the event of a favorable decision by the court.

Summary of Argument.

For upwards of fifty years it has been accepted law and practice that a decree entered by a court of equity in an action under Section 4915 R. S. was not so far conclusive upon the Commissioner of Patents that upon the filing of a copy of the decree with him he had no alternative but to comply therewith immediately and issue the patent as di-

rected. The statute merely provides that a successful plaintiff is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and *otherwise complying with the requirements of law.*" The action of the court below, in refusing to take jurisdiction and decide the issues presented, even though an interference might and undoubtedly would be set up between the Jewett application and the Veazey patent, aforementioned, is inconsistent with the language of this Court in *Gandy* v. *Marble,* 122 U. S. 432, 440:

> "* * * All that the court which takes cognizance of the bill in equity, under section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

One of the other "requirements of law," contemplated by this statute, is that set out in Section 4904 R. S., U. S. C. Title 35, Section 52 (Appendix p. 36), wherein the Commissioner is directed to institute procedure for determining the question of priority between the "applicant and patentee."

The question of the district court's jurisdiction depends upon the construction of Section 4915 R. S. and is of great public importance.

This Court has not ruled upon the question of the district court's jurisdiction of an action brought under Section 4915 R. S. in a case in which, following a decision favorable to the complainant, further prosecution might take place in the Patent Office, and the decision of the Court of Appeals for the District of Columbia has not given proper effect to the applicable decisions of this Court.

The judgment and opinion of the court of appeals holding that that court has no jurisdiction of an action brought

under Section 4915 R. S. *unless its judgment may be made final and binding upon the Commissioner of Patents* may seriously hinder and confuse the administration of the law in the Patent Office, particularly with respect to Section 4904 R. S. (Appendix p. 36). The provision in Section 4915 R. S. of a "remedy by bill in equity" * * * "whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners," provides for remedies under two separate conditions.

In an action brought under Sec. 4915 R. S. by an applicant against the Commissioner of Patents, after refusal of a patent by the Board of Appeals, a third party (patentee) claiming the same invention is not a necessary party where no interference between the application and the third party's patent was instituted by the Patent Office.

Argument.

1. The facts of this case are on all fours with the facts in the Hoover case and, in view of the prior decision of the District Court in respect to Petitioner's Application, in a sense presents an even stronger factual situation.

In view of paragraph 6 of the findings of the district court (Judge Luhring) in the R. S. 4915 action involving the same Jewett application Serial No. 700,632, it has, in effect, been adjudicated that the operation of the process of the Jewett invention responds to and infringes, and hence the application defining the same *supports*, claims 8 and 9 of the Veazey Patent No. 2,142,540 (R. 197) which have been copied into the said Jewett application as claims 71 and 72 (R. 25). Jewett filed his application on December 1, 1933, whereas Veazey filed his application on July 31, 1934 (about eight months later), as shown by the patent (R. 193). The court of appeals states, as a truism, that if a mistake was made by allowing the claims to Veazey it would not help matters to perpetuate the mistake by allowing the same

claims to Jewett. But the Commissioner has not challenged the validity of these claims in the Veazey patent, and it follows that they would be *a fortiori* allowable in the Jewett application, filed eight months earlier than Veazey's filing date. These claims remain otustanding and presumptively valid in the Veazey patent. Lacking a holding by the court of appeals that claims copied from a patent are unpatentable, the court should rule directly on the question of support; and where it finds that the claims are supported by the application of the appellant, then the Commissioner may, upon the appellant's "filing in the Patent Office a copy of the adjudication" take appropriate action under Section 4904 R. S. to set up an interference, as provided by Section 4915 R. S., as a part of requiring the applicant *otherwise to comply with the requirements of law*, and the Commissioner may or may not subsequently issue a patent to the applicant, depending upon whether he is satisfied that the applicant has *otherwise complied with all the requirements of law*. But the court of appeals should decide the appeal on the basis of the issues presented, and should not refuse to decide the question of support in the application of the appellant, and should not dispose of the appeal simply by conjecturing that the claims copied from the patent might conceivably be invalid, when the claims remain outstanding and presumptively valid in the patent of another and later applicant.

2. The importance of the questions presented.

Ever since *Gandy* v. *Marble*, 122 U. S. 432, it has been accepted practice that a decree entered by a court of equity in an action under Section 4915, Revised Statutes, was not so far conclusive upon the Commissioner of Patents that upon filing of a copy of the decree with him he had no alternative but to comply therewith immediately and issue the patent as directed.

The statute merely provides that a successful plaintiff is only entitled to a patent upon "filing in the Patent Office

a copy of the adjudication *and otherwise complying with the requirements of law,*" and construing this language in *Gandy* v. *Marble*, this Court said (p. 440):

> "* * * All that the court which takes cognizance of the bill in equity, under Section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

In view of the foregoing decision, as well as the clear language of the statute, the right of the Commissioner of Patents to refuse to execute the decree entered in a 4915 action, if the successful plaintiff fails to pay the fees required by law or to meet other conditions required of him by the patent statutes and the rules of the Patent Office, cannot be challenged. Similarly the decree for all practical purposes is rendered a nullity where, after its filing, the Commissioner of Patents, while preparing to issue a patent, discovers the pending application of another claiming the same subject matter and is consequently required by law to declare an interference. It clearly appears from the memorandum which was presented by respondent to the court below in the *Hoover case*, that the administrative practice of the Patent Office consistently pursued throughout the years was admitedly contrary to the practice now dictated by the instant decision. By way of aiding the court below in its construction of the statutes involved, respondent informed the court of the existence of an administrative interpretation of long standing that, upon the filing of an adjudication favorable to an applicant, the Patent Office claimed the right to exercise, and did actually exercise, its prerogative "to proceed in accordance with other sections of the patent statutes." It was pointed out to the court that while the language of Section 4915 might appear to make the

adjudication mandatory and immediately effective, it was thought "that it is proper to consider it as a part of the entire patent law and hence co-ordinate with Section 4904 R.S., which provides for the declaration of an interference where an application for patent is found to be in conflict with another application, or an unexpired patent. It is not until it is found that a claim in an application is patentable to the applicant that such a conflict exists. Therefore, when it is determined by the adjudication of the court that the conflict exists, Section 4904 R. S. comes into play and the interference must be declared, notwithstanding the form of the judgment." *

In the face of this administrative interpretation by the Commissioner of Patents, and despite these unambiguous representations by him that no practical obstacles have been or are presented by a decree adjudging that an applicant is entitled to receive a patent, the court below nevertheless refused to assume jurisdiction of an action under Section 4915 in respect to the main issues herein because it considered that its decree could not be immediately carried out, but instead would result in an interference. The court below, holding that it was powerless to determine petitioner's "right to a patent" because it involved deciding

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*Respondent in the *Hoover* case called attention to the fact that, under prevailing administrative practice, interferences have been declared by the Patent Office upon the filing of an adjudication that an applicant was entitled to receive a patent. Thus the court was informed that, after the decree entered in *Tully* v. *Robertson*, 19 F. (2d) 954, where the right of an applicant to copy claims from an unexpired patent and thus provoke an interference had been upheld, the interference was declared, notwithstanding the adjudication in favor of the plaintiff. Attention was specifically called to *International Cellucotton Products Co.* v. *Coe*, 85 F. (2d) 869, and *American Cyanamid Co.* v. *Coe*, 106 F. (2d) 851. In those cases, after the dissolution of interferences set up by the Patent Office, the applicants on the *ex parte* prosecution of the application were refused certain claims on the ground of estoppel. Actions under Section 4915 were successfully prosecuted and upon the filing of the favorable adjudications the interferences were re-declared and prosecuted to decision.

that he is prior to another applicant,—not before the court —concluded, in effect, that the "whole controversy" had not been presented and that consequently there was no jurisdiction.

Thus not only is the question decided by the court below of general importance, but it is one of substance relating to the construction of statutes of the United States which has not been, but should be, settled by this Court. We respectfully submit, moreover, that the court below has not given proper effect to applicable decisions of this Court and that the instant decision, if erroneous, will produce unfortunate consequences in practice.

In *Butterworth* v. *Hill*, 114 U. S. 128, it was held by this Court that an action under Section 4915 may not be maintained against the Commissioner of Patents without his consent, where he is the sole defendant, save in the district of his official residence, and consequently it is within the power of respondent to require that all actions by applicants to whom patents are refused in *ex parte* cases be brought in the District Court for the District of Columbia. Hence the nature of the questions presented and the improbability that other inferior courts will ever have an opportunity to pass upon these identical questions should move this Court to grant the instant petition (cf. *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464; *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 47; *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126).

3. The decision below is contrary to the clear and unambiguous language of the statute and is in conflict with a liberal legislative policy calculated to afford applicants for patents ample remedy by a suit in equity in every case where a patent is refused.

The enactment now found in the statutes of the United States on the subject of the availability to a defeated applicant for a patent of a remedy by suit in equity is the result of a long course of legislation. A review of this background

plainly reveals a liberal legislative policy inconsistent with the narrow and restricted view which was taken by the court below. However plausible Judge Arnold's arguments may be, the construction imposed by him upon the statute involved does not square with the words actually used in the statute and is in obvious conflict with its general Congressional purpose.

The first legislation dealing with a suit in equity by an applicant who had been refused a patent is found in the Patent Act of 1836. (Act of July 4, 1836, ch. 357, 5 Stat. 117) (Appendix pp. 32, 33).

By Section 7 of that Act the Comissioner of Patents was authorized, on the filing of an application for patent, to make an examination of the alleged new invention or discovery and it was declared to be his duty to issue a patent if he "shall deem it to be sufficiently useful and important"; in case of the Commissioner's refusal to issue a patent, the applicant was secured an appeal from this decision to a board of examiners. The decision of this board being certified to the Commissioner, it was declare dthat "he shall be governed thereby in the further proceedings to be had on such application."

By Section 8 it was provided that if in the opinion of the Commissioner an application "would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted" he was authorized, after notice to the parties, to decide the "question of priority of right or invention." An appeal to the board of examiners as in the case of other refusals was provided in these cases of interference.

Section 16 of the Act* (Appendix p. 33) provided, in part:

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*It should be mentioned that this section also related to a suit in equity "whenever there shall be two interfering patents." The proceedings were separated by the Act of 1870 (C. 230, 16 Stat. 198, Sections 52, 58). Actions relating to interfering patents are now covered by Section 4918 (35 U. S. C. Section 66).

> "That * * * whenever a patent on application shall have been refused *on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted,* * * * any such applicant * * * may have remedy by bill in equity, and the court having cognizance thereof * * * may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention as specified in his claim, or for any part thereof, *as the fact of priority of right or invention shall in any such case be made to appear.* * * *"

It will thus be observed that as enacted this section limited the "remedy by bill in equity" to cases of interference. The right of an applicant to appeal to the courts to review the action of the Patent Office was available only when the application had been refused "on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted." In all other cases the decision of the board of examiners was final. No provision had been made for an independent judicial review in those cases.

By Section 10 of the Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353) (Appendix pp. 33, 34), the provisions of Section 16 of the Act of 1836 were extended to *all cases* where patents were refused "*for any reason whatever,*" either by the Commissioner of Patents or by the Chief Justice of the District of Columbia,* upon appeals from the decisions of the Commissioner, "as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent."

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*By Section 11 it was provided that in all cases where an appeal was then allowed by law from the decision of the Commissioner of Patents to a board of examiners, an applicant, instead thereof, should have a right of appeal to the Chief Justice of the District Court of the United States for the District of Columbia.

Thus there was evinced by Congress more than a century ago an intention to make available to persons seeking patents the right to secure, by bill in equity, an independent judicial review in all cases where the Patent Office had refused a patent *for any reason whatever.* It would seem that all argument might therefore well close here, for only compelling language could justify a conclusion that Congress intended to abandon its avowed policy and, as will presently appear, no subsequent enactment of Congress has taken away any of the comprehensive power clearly conferred upon the courts at that early date.

By the Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198) (Appendix pp. 34, 35) the provisions of Section 16 of the Act of 1836 and of Section 10 of the Act of 1839 were combined into Section 52 of that Act, as follows:

> "Section 52. *And be it further enacted,* That whenever a patent on application is refused, *for any reason whatever,* either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, *as the facts in the case may appear.** And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law."

In view of the language of the prior enactments and especially in view of the provision in Section 52 of the Act

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*The italicized words constitute a broadening and significant departure from the limited language of the predecessor statute, *i. e.*, "as the fact of priority of right or invention shall in any such case be made to appear."

of 1870 that the remedy by bill in equity was available in the case of a refusal "for any reason whatever," a Congressional purpose in favor of the applicant in all cases, far from being shown to have receded, is clearly carried forward. The right to a "remedy by bill in equity" in all cases was thus emphasized once more.

When the statutes were revised in 1874, we find that the words "for any reason whatever" appearing in Section 52 of the Act of 1870 were omitted from Section 4915 (Act of June 22, 1874, Section 4915); but certainly no one will contend that there is any difference between the words "*refused* for any reason whatever," as was provided in the Act of 1870, and the word "*refused*," as specified in Section 4915. It must be conclusively presumed that the revisers of the statutes recognized the equality of the expressions. It cannot be implied that any detraction of the right to a "remedy by bill in equity" was intended or that any decrease in the jurisdiction of the courts to make an independent judicial review flows from the deletion of the words "for any reason whatever."

If, originally, jurisdiction was conferred upon the courts solely for the purpose of reviewing and correcting refusals based on account of interference with a previously existing patent, and if such jurisdiction was subsequently extended to *all cases* where patents had been refused "for any reason whatever," we can see no justification for now holding that the Federal Courts have no jurisdiction because the issue of priority between an applicant and an existing patent is not also presented for determination. Such an issue was the only one which originally could have invoked the remedy by suit in equity, but the jurisdiction of the courts was subsequently expanded to apply to refusals on other grounds, and it does violence to a clearly expressed legislative policy to hold, as did the court below, that jurisdiction is wanting merely because the priority issue as between the applicant and a known unexpired patent is not presented.

There is no difference in principle between an action under Section 4915 followed by a declaration of an interference betwen the successful plaintiff and an applicant not previously known or contemplated and an action which is avowedly prosecuted in order to lay the foundation for the declaration of an interference with an existing patent with which the defeated applicant desires to contest priority. In the former case, the courts admittedly have jurisdiction. No decision—prior to that of the court below—has questioned the right of a person seeking a patent to prosecute a bill in equity in the latter case.

Orderly procedure dictates, contrary to the views of the court below, that where an interference with an unexpired patent is being provoked, the prior patentee should not be required to litigate until the defeated applicant has established his right to the claims and to an interference. Thus in *Robinson on Patents* (Vol. 2, Section 722, p. 463), that eminent patent law authority, commenting upon the separation by the Act of 1870 of proceedings involving interfering patents and those involving an applicant and a patent, said:

> "* * * The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defense of the prior patent, or compel him to incur the risk of its repeal. The present law thus adequately protects the interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies."

The decision of the court below also seemingly questioned both the power and purpose of Congress to provide for a review by bill in equity of an administrative ruling made in the preliminary stage of an interference and thus imputes a Congressional intent not to affect the principles of equity jurisdiction.

A forcible statement of the principle applicable here was made in *United States* v. *Duell,* 172 U. S. 576, when Mr. Chief Justice Fuller said (p. 583):

> "Since, under the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that *Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object.*"

In that case it was held that the competency of Congress to provide for "judicial interference" with the action of the Patent Office cannot be successfully questioned as being an encroachment upon the judicial department. Hence, the view of the court below that assumption of jurisdiction in a case like the present one, is "contrary to the fundamental concept of equity jurisdiction" * is in conflict with the holding in *United States* v. *Duell,* that:

> "* * * The nature of the thing to be done being judicial, Congress had power to provide for judicial interference through a special tribunal, *United States* v. *Coe,* 155 U. S. 76; and *a fortiori* existing courts of competent jurisdiction might be availed of."

*Quoted from the opinion below in *Hoover* v. *Coe.*

4. The decision below is contrary to the rule of construction adopted by this Court in Baldwin Co. v. Robertson, 265 U. S. 168.

In circumscribing the nature of the relief which a court in a Section 4915 action has the power to grant, the court below has placed itself squarely in conflict with the decision of this Court in *Baldwin Co.* v. *Robertson,* 265 U. S. 168.

By way of preface to an explanation of that case, it should be mentioned that in *Atkins & Co.* v. *Moore,* 212 U. S. 285, 291, *American Steel Foundries* v. *Robertson,* 262 U. S. 209, and *Baldwin Co.* v. *Howard Co.,* 256 U. S. 35, 39, this Court held that the assimilation of the practice in respect of the registration of trade marks to that in securing patents as enjoined by Section 9 of the Trade Mark Act (33 Stat. 727, c. 592) made Section 4915, providing for a bill in equity to compel the Commissioner of Patents to issue a patent, applicable to a petition for the registration of a trade mark when rejected by the Commissioner.

The case presented in *Baldwin Co.* v. *Robertson* involved, however, not a bill under Section 4915 to review and correct the action of the Commissioner in refusing a trade mark registration, but instead, a bill under that section seeking an *injunction,* to prevent the Commissioner from cancelling certain trade marks which had already been registered by the plaintiff. *Thus the case was not one wherein the court was requested to adjudge that the plaintiff was entitled to receive a trade mark registration.*

Against jurisdiction to entertain such a bill it was expressly argued in that case that Section 4915 did not authorize the action (p. 169) and that to interpret Section 4915 as authorizing the action "requires a rewriting of Section 4915, and the incorporation into the section of both words and subject matter entirely foreign to its present plain language" (p. 171). Rejecting these contentions, Mr. Chief Justice Taft said (265 U. S. 179):

> "The next inquiry is whether, in addition to such appeal and after it proves futile, the applicant is given a remedy by bill in equity as provided for a defeated applicant for a patent in Section 4915, Rev. Stats. We have in the cases cited given the closing words of Section 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade marks that is afforded in proceedings as to patents, and have held that under them a bill of equity is afforded to a defeated applicant for trade mark registration just as to a defeated applicant for a patent. *It is not an undue expansion of that construction to hold that the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by Section 9 an appeal first lies to the Court of Appeals.* This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade mark, after an unsuccessful appeal to the advisory supervision of the Court of Appeals, *a right to resort to an independent bill in equity against the Commissioner to prevent cancellation.*"

Baldwin Co. v. *Robertson* clearly reveals that the purpose of Section 4915 is to afford a defeated applicant for patent an independent judicial review in every case where the Patent Office has made a final adverse decision. It demonstrates, moreover, the error into which the court below fell when it assumed that the only power under Section 4915 which a court has is that of making a decree authorizing and directing the Commissioner to issue a patent. If a court may enter an injunction in the exercise of its jurisdiction under Section 4915, then *a fortiori* it may make a decree "directing the Commissioner to find claims readable on plaintiff's disclosure and allowable to him provided that later he is determined to have priority." *

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*Quoted from the opinion below in *Hoover* v. *Coe.*

5. The decision below adopts a rule of statutory construction which nullifies the legislative purpose to provide alternative remedies to defeated applicants for patents and which is contrary to the interpretation of the same statute made by the Courts of the Second and Third Circuits.

By the Act of March 2, 1927 (Chap. 273, Sections 8, 11, 44, Stat. 1336), Section 4911 and 4915 were amended to provide that if an applicant for patent appealed to the Court of Appeals of the District of Columbia,* he waived his right to proceed under Section 4915.

Thus Section 4911 provides that an applicant may have a direct appeal to the Court of Customs and Patent Appeals but that, in that case, "he waives his right to proceed under Section 63" (Section 4915) and Section 4915 provides that if an appeal is taken or is pending or is decided "no action may be brought under this section."

These amendments have been regarded as providing alternative remedies for an applicant who is dissatisfied with the decision of the Board of Appeals or the Board of Interference Examiners. Thus Rule 149 of the Patent Office provides:

> "If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under Section 4915 R. S. (U.S.C. Title 35, Sec. 63).
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> "From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appelant, if an applicant, has the option of proceeding under Section 4915 R. S.

*In 1929, the jurisdiction of the Court of Appeals, D. C., to entertain a direct appeal was transferred to the U. S. Court of Customs and Patent Appeals. Hence, the references in these sections to the Court of Appeals of the District of Columbia were changed to read "United States Court of Customs and Patent Appeals" (Act of March 2, 1929, c. 488, Section 2, 45 Stat. 1476).

instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

The court below refused to recognize the 1927 amendments or to sanction the Patent Office rule. Indeed, it was held, in effect, that the petitioner's remedy in the instant circumstances resided solely in an appeal to the United States Court of Customs and Patent Appeals. If it be conceded that an appeal in the instant case lay to that court, then by the clear language of Sections 4911 and 4915, the remedy by bill in equity is also available. Those sections clearly provide alternative remedies for reviewing a refusal to issue a patent and have been so construed in cases arising in other circuits.

Thus in *Bakelite Corp.* v. *National Aniline & Chemical Co.* (C. C. A. 2), 83 F. (2d) 176, 177, the court said:

> "It cannot be doubted that the statute, as it now reads, *means to give alternative remedies to an applicant to whom a patent has been refused.* He may appeal, 'in which case he waives his right to proceed under section 63 of this title' (35 U. S. C. A. Section 59a); or he may have his remedy by bill in equity, 'unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section.' (35 U. S. C. A. Section 63)."

In *General Talking Pictures Corp.* v. *American Tri-Ergon Corporation, et al.* (C. C. A. 3), 96 F. (2d) 800, 812, the court referring to the 1927 Amendment said (p. 812):

> "In our opinion the amendment has two practical results:
>
> "First, it provides that the losing party in an interference is not entitled to his remedy by suit if an appeal to the United States Court of Customs and Patent Appeals is pending or has been decided."

The logic of the contention that if an applicant is refused a patent on the ground that the claims do not read upon his disclosure he has the right to appeal to the Court of Customs and Patent Appeals, then he also has the right to secure a review of the same type of refusal by way of a suit in equity under Section 4915, cannot be disputed. It is based upon the *alternative* and *optional* character of those remedies as provided by Congress. The force of a similar contention was recognized in *Baldwin Co.* v. *Robertson, supra*, when it was held that it was not an undue expansion of the statute to hold that a remedy in equity against the Commissioner was furnished "in every case in which by Section 9 an appeal first lies to the Court of Appeals."

The construction which has been imposed upon Sections 4911 and 4915 by the court below deprives an applicant whose claims, copied from an unexpired patent, have been refused, from availing himself of the right clearly expressed in Section 4915 to file a "bill in equity" instead of taking an appeal to the United States Court of Customs and Patent Appeals.

Conclusion.

By reason of the principles which have already been discussed at length in *Hoover Co.* v. *Coe*, No. 486, both in the brief of the petitioner and of Paul A. Sturtevant, as *amicus curiae*, pursuant to which a writ of certiorari was granted therein on November 6, 1944, as well as for the reasons set out hereinabove, the present petition for writs of certiorari should be granted.

Respectfully submitted,

HAROLD J. KINNEY,
Attorney for Petitioner,
Minnesota Mining & Mfg. Co.

CHAS. S. GRINDLE,
Of Counsel.

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